

REMARKS

Reconsideration of the subject application in view of the above amendment is respectfully requested.

By the present amendment, the drawings (Fig. 1) and the specification have both been amended to address the Examiner's objections thereto.

Claims 1, 2 , 5 and 6 and 7 have been amended.

The Examiner has required Applicants to submit a copy of the search report cited in the Information Disclosure Statement filed on December 13, 2004. Applicants submit herewith an Information Disclosure Statement citing such art together with a copy of such art and a copy of the search report.

Based on the foregoing amendment and the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

I. Objection to the Drawings

The Examiner has objected to the drawings for failing to show the conventional names, as described in the specification. The Applicants have amended the drawings to overcome such objection.

The Examiner has also objected to the drawings for failing to show every feature of the invention specified in the claims, in particular the upper section. The Applicants have amended the drawings to overcome such objection. Accordingly, Applicants respectfully request withdrawal of this objection to the drawings.

In view of the above, the Examiner is respectfully requested to approve the foregoing amendments to the drawings (replacement sheets, together with a letter to Official Drafts person, are enclosed) and to withdraw the objections to the drawings.

II. Objections to the Specification and Claim 5

The Examiner has objected to the specification and claim 5 based on informal errors contained therein. The specification and claim 5 have been amended to correct such informal errors. Accordingly, Applicants respectfully request approval of the amendments to the specification and claim 5 and withdrawal of the objections thereto.

III. Rejection of the Claims

IIIa. Rejection Under 35 U.S.C. §112

The Examiner has rejected claims 1-6 under 35 U.S.C. §112, second paragraph, for being indefinite. The Applicants have amended the claims to

overcome these rejections. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 1 and claims 2-6 that depend therefrom under 25 USC 112, second paragraph.

III b. Rejection of claims under 35 USC §102(b)

The Examiner has rejected claims 1 and 7 under 35 U.S.C. §102(a), as being anticipated by U.S. patent 6,218,807 to Sakaue et al. (Sakaue). The Examiner has rejected Claim 1, 2 and 6 under 35 U.S.C. §102(a), as being anticipated by JP-08185898 (hereinafter JP). Applicants respectfully disagree.

Sakaue does not disclose any charge electronics arranged to transfer heat in the air flow. Sakaue only shows (Figs. 1, 3a and 3b) a blower 12 arranged between a flow inlet side 22 and a flow outlet side 11 without any charger electronics or heat transfer means connected to the charger electronics. As described in the specification (c6:42-44) the heat generating circuit parts of the charger electronics are provided in the charger section 6, separated from the air flow by a shielding wall part 31 (c6:36-42; Fig. 4a). Thus, the arrangement is such that the heat of the heat generating circuit parts can be shielded by the shielding wall part 31 (c7:2-5). This is opposite the teaching of the invention. Thus, claim 1 and 7 are not disclosed by Sakaue.

JP, in contrast to the Examiner's reading of such reference, discloses, at pos. 25, a charger (electronic) that is arranged to transfer heat in the air flow.

The blower 24, however, is completely arranged outside of the charger housing (see the thin housing line surrounding the blower 24 at the top, right side and the bottom disclosing an outside recess for the blower 24) also not arranged inside the charger housing between two air vents. Thus, any outlet vents are completely missing or alternatively arranged to the right of the blower 24 not arranged between two air vents. Thus, the Fig. of JP discloses fairly different subject matter than the invention and would not be used by one skilled in the art looking for a solution for an optimal arrangement of a blower inside the air flow between an inlet vent and an outlet vent of a charger housing.

The Federal Circuit has mandated that 35 U.S.C. § 102 requires no less than “complete anticipation...[a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See also, Electro Medical Systems, 32 U.S.P.Q. 2d at 1019; Verdegaal Bros., 2 U.S.P.Q. 2d at 1053.

In view of the above, since neither JP or Sakaue disclose all the features of claim 1, it is respectfully submitted that JP and Sakaue each do not anticipate the present invention, as defined by claim 1. It is respectfully submitted that claim 1 is patentable over the prior art. Accordingly, it is respectfully submitted that claims 2, 6 and 7 that depend therefrom respectfully are patentably distinct

over each such art and thus withdrawal of such rejection over such claims is respectfully requested.

III c. Rejection of claims under 35 USC §103(a)

The Examiner has rejected claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over JP in view of Sakaue. Applicants respectfully disagree with this rejection.

It is respectfully submitted that the present invention, as defined in independent claim 1 and claims 4 and 5 that depend therefrom, would not be obvious over such references.

A critical distinction between the invention and the prior art is the arrangement of the air blower between the air vent on a flow inlet and the charger electronics, both lying (serially) in the same current, as claimed in claim 1 and claims 2-7 that depend therefrom. A strong flow through the battery is achieved only through this arrangement (p. 4, ln. 2) and not a further flow resistance of the charger electronics in the suction path or a suction loss divided by a parallel flow path. Neither JP or Sakaue disclose or teach the solution claimed in claim 1 and claims 2-7 that depend therefrom. One skilled in the art would not rely on these references since they disclose different arrangements of a blower relating to the charger housing as discussed above.

Under MPEP § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that the first element of *prima facie* obviousness has not been established.

“obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so.”

In re Fritch, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir 1992) (footnote omitted) (emphasis in original). See also In re Sernaker, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983): SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8

U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); In re Fine, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in the cited references for the combination on which the Office Action relies. A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness.

MPEP §2143.01 relying on Ex Parte Levengood, 28 U.S.P.Q. 2d 1300 (Bd. Pat. App. & Inter. 1993). In order to establish a *prima facie* case of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggesting incentive or influence in the prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings.” Id. At 1301 (emphasis in original).

The Court of Appeals for Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record as any *evidence*, other than the PTO’s speculation (if it be called evidence) that one skilled in the art would have been motivated to make the modification of the prior art “necessary to arrived at the claimed invention. In re Jones 21 U.S.P.Q. 2d 1941 (Fed. Cir. 1992).

Ex Parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App & Inter. 1985)

requires that when the references do not suggest the invention “. . . the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teaching of the references.” No such line of reasoning is seen in the Office Action.

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or template to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

In the In re Fritch holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicants’ own statements”, that the prior art must be viewed “without reading into that art Appellant’s teachings”, and that that teachings of the prior should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the original text) make the invention as a whole, obviously.” In *re Sponnoble*, 160 U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious.

The Court of Appeals for the Federal Circuit has consistently ruled that it is not permissible to use hindsight to reject a claim.

As pointed out in *Uniroyal v. Redkin-Willey*, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988):

When prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

There is nothing in the prior art that would suggest combining such references to achieve the claimed invention.

In view of the above, it is respectfully submitted that none of the references alone or in combination make the present invention, as defined in Claim 1, obvious, and the present invention is patentable over such referenced.

Claims 2-7 depend on Claim 1 and are allowable for the same reasons Claim 1 is allowable and further because of specific features recited therein which, when taken alone and/or in combination with features recited in Claim

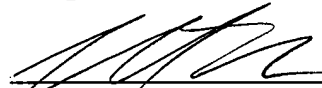
1, are not disclosed or suggested in the prior art. Accordingly, Applicants respectfully request withdrawal of the rejection to claims 1-7 under 35 USC 103 (a) over such prior art.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

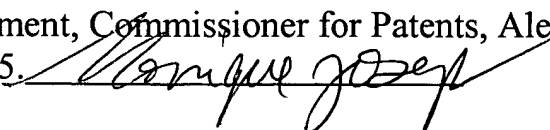
Respectfully Submitted,



Ronit Gillon
Reg. No. 39,202

Dated: May 16, 2005
Sidley Austin Brown & Wood LLP
787 Seventh Avenue
New York, N.Y. 10019
Tel.: (212) 839-7354

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail and addressed to: Mail Stop Amendment, Commissioner for Patents, Alexandria, VA 22313-1450 on May 16, 2005.



IN THE DRAWINGS:

Replace Fig. 1 with new Fig. 1 shown in the replacement sheet of Fig. 1.